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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,525	06/28/2001	John D. Barnard	2908.P3	4923
5514	7590	01/27/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			TANG, KAREN C	
		ART UNIT	PAPER NUMBER	2151

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/892,525	BARNARD ET AL.
	Examiner Karen C. Tang	Art Unit 2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11, 14-39, 42-67, 70-95 and 98-120 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11, 14-39, 42-67, 70-95, 98-120 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/20/04</u> | 6) <input type="checkbox"/> Other: _____. |

- A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/05 has been entered.
- Claims 1, 14, 15, 29, 42, 43, 57, 70, 71, 85, 98, and 99 are amended, and claims 1-11, 14-39, 42-67, 70-95, 98-112 are present for further examination. New Claims 113-120 are added.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on judicially created doctrine grounded in public policy (a policy rejected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi* 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11, 14-39, 42-67, 70-95 and 98-112 are rejected on the ground of nonstatutory double patenting over claims 1-184 of U. S. Patent No. 6,920,506 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Although the conflicting claims are not identical, they are not patentably distinct from each other because Context of the claimed invention in the instant application is analog to the context of the claimed invention in the patented application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. The text of those sections of Title 35, U.S. Code 103(a) not included in this action can be found in a prior Office Action.

4. Claims 1-8, 10-11, 14, 19-23, 28-36, 38-39, 42, 47-51, 56-64, 66-67, 70, 75-79, 84-92, 94- 95, 98, 103-107 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al (EP 952513. White", hereinafter) and Richter et al. (US 6.678.068 "Richter." hereinafter).

5. Regarding claims 1, 28-29, 56-57, 84-85, and 112-120, White discloses a method, system and computer programs record in computer readable mediums (a "system" hereinafter), for managing a plurality of printing devices connected on a network, comprising means, steps and instructions for: detecting a printing device connected on the network; requesting information from the detected printing device; receiving the requested information from the printing device; creating a print queue for the printing device based on the received information; accessing user- configurable parameters for the print queue (abstract, Fig.1; 13, indicates that users-configurable parameters in fact is prior art to White; 18). White is silent on publishing print queue to network. However, publishing print queue, i.e., displaying, announcing, notifying presenting advertising, print queue or status of printer, print's queues or print's spool to a client device in a network, was conventional, which had readily been employed long before the instant invention was made. White teaches accessing policy rules for the print queues (users are able to config proper parameters (accessing policy rules)), and publishing the printer

queue to the network according to said policy rules (so that the printer can be utilized for the network due to the configuration)). White also discloses the policy rules (conf proper parameters, 0002) regulates use of the print queue by client workstations connected to the network (the configuration parameters allows the printer to be used on the network).

The configuration parameters are entered by the user (administrators).

Evidently, in the same field of endeavor, Richter, clearly teaches the same (see Richter, figures 24-30, and corresponding details Col. 13, line 25 et seq.) Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate a publishing- print-queue idea or the like with White, autonomous configurable print queue system. Because, such combination or modification would enable users to obtain status or printers or prints' queue, and/or locations, availability of printing device from server without having to physically walk to specific printing locations), thereby increasing user convenience and reducing time unnecessary time consuming, which in turn would improve efficiency of the operation-unit.

6. Regarding claims 2-8, 10-11, 19-23, 30-36, 38-39, 47-51, 58-64, 66-67, 75-79, 86-92, 94- 95, and 103-107, White-Richter discloses the system further includes, detecting an address assignment message sent between an address server and the printing device over the network (White-Richter's system also employs DHCP standard, White teaches printer driver, i.e., type and capability of printer included, is transmitted to printing system, White's 13, 18).

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7. Claims 9, 37, 65 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over White-Richter as applied to claims 1, 29, 57, 85 above and Clough (US 6,820,124).

8. Regarding claims 9, 37, 65 and 93, White-Richter discloses the invention substantially, as claimed, as described, but it is silent on communication by using SNMP. However, SNMP are standard for communicating message with a network, specifically it has been utilized in particular for communicating message between printer and its host, the aforesaid is evidently taught in Clough. Thus, including a standard that is set forth for specific purpose for functioning the same would have been obvious to one of ordinary skilled in the art. Because, adopting SNMP for communication messages, as suggested in Clough, would be a simplistic process of desiring system and enhancing system's flexibility, in which ordinary artisan would look for, before reinvent a new way of communication.

9. Claims 14-18. 24-27. 42-46. 52-55. 70-74. 80-83. 98-102 and 108-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over White-Richter, as applied to claims 1, 29, 57 and 85 above and Lee (US 6,628,413).

10. Regarding claims 14-18, 24-27, 42-46, 70-74 and 98-102, White discloses the invention substantially, including configuring IP addresses, print queue name, print server and its capabilities (White's teaching printer acquire IP address using DHCP 15; Richter teaches GUI, publishing IP address (266) in figure 24, printer or queue name

(124) in figure 25, capabilities (166) in figure 24). White-Richter is silent on including MAC address and printing policy with a configurable parameter. However, MAC address is inherent in network computing device, thus to include the MAC address as a configuration parameter would have been obvious to one having ordinary skill in the art at the time of the invention was made that was a matter of choice, since White-Richter clearly is capable of configuring printing device using IP address as configurable parameter, thus, using other type of address, such as MAC address, would be conceivable to an artisan. In addition, in the same field of endeavor, Lee teaches an inventive concept that uses JAVA programming to create print queue(s) web page(s), which contains a plurality of links representing each of the print queue(s) entries in the print queue(s) configurable database. Further, Lee also teaches that the JAVA printer is widely utilized for publishing printer queue(s) on a web page to enable clients to control printer. Furthermore, Lee teaches publishing rules and allowing user or administrator to change rules for controlling printer tasks, maximum job size, what type or image and to whom the print cost should be allocated, i.e., printing policy (Lee, Fig. 3). Thus associated printer queue with web page is not new, but rather would have been obvious to one of ordinary skill in the art at the time of the invention was made to do so, because it would enable users or administrators to remotely configure or reconfigure or control printers' operation in various applications, including cost control, as suggested in Lee (Co1. 4, line 22- Col. 5, line 55 and Fig. 3).

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11. Applicant's arguments filed 10/17/05 has been fully considered have been considered but are not persuasive.

Applicants argue that the references do not suggested alone or in combination that (i) the accessing of policy rules for a print queue (ii) the creation of a print queue based at least in part on the policy rules.

Examiner traverses the argument: (i) White taught accessing policy rules for the print queues (users are able to configuration proper parameters (accessing policy rules)), and publishing the printer queue to the network according to said policy rules (so that the printer can be utilized for the network due to the configuration)).

(ii) White also disclosed the policy rules (conf proper parameters, 0002) regulate the use of the print queue by client workstations connected to the network (the configuration parameters allows the printer to be used on the network). Applicants admit that White did teach the creation of the queue (creation of the queue, argument filed on 10/17/05), and Applicant should understand that the printer queue was created by the software program "network plug and play" and is obvious that the program comprise configuration/rules, and the printer queue is created by the policy rules.

Conclusion

12. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

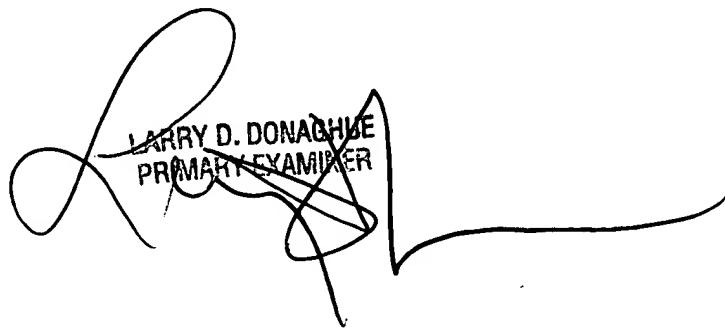
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karen Tang



LARRY D. DONAGHUE
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be "LARRY D. DONAGHUE". Overlaid on the signature is printed text in capital letters: "LARRY D. DONAGHUE" on the top line and "PRIMARY EXAMINER" on the line below it.